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JUL 13 1999

In re Application of
Monosov and Fu
Application No. 09/023,232
Filed: February 13, 1998
For: NUDE MOUSE MODEL FOR
HUMAN NEOPLASTIC DISEASE

**SPECIAL PROGRAMS OFFICE
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: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)
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This is in response to the "Petition Under 37 CFR 1.47(a)," filed October 19, 1998.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on February 13, 1998 without an executed declaration.

Accordingly, on March 16, 1998, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration, and a surcharge for its late filing.

In response, on October 19, 1998, the instant petition was filed. The petition was accompanied by a copy of the Notice, with the last three digits of the attorney docket changed from "312762001430" to "530". Also included with the petition was a Consent of the Assignee, the instant petition, a certificate under 37 C.F.R. § 3.73(b) and a reissue application declaration and power of attorney signed by joint inventor Fu. The petition states that Monosov and Fu are joint inventors for the application and that Mr. Fu signed a declaration for the application, but that the declaration was defective because the wrong address was stated. The petition further states that a new declaration was sent to Mr. Fu, but that Mr. Fu was believed to have moved without a forwarding

address. A Reissue Application Declaration and Power of Attorney by Inventor for U.S. Patent No. 5,491,284 (the wrong patent number, it appears that this patent also has a reissue application with a similar docket number), signed by joint inventor Monosov was also filed.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks items (1) and (2) set forth above.

As to item (1), applicant has not established either that joint inventor Fu has refused to join in the filing of the above-identified application or that he cannot be reached after diligent effort. Mr. Fu did sign a declaration, albeit a declaration with an incorrect address. Since Mr. Fu has signed a reissue declaration, he has not refused to join in the filing of the application. As to the difficulty in reaching Mr. Fu for purposes of signing the supplemental declaration, applicant has not established that he cannot be reached after a diligent effort because applicant has not shown what efforts were made to obtain a forwarding address from Mr. Fu or what other efforts were made to reach Mr. Fu. In order to establish that Mr. Fu cannot be reached, applicant should submit a statement describing the efforts made to reach Mr. Fu from someone with first-hand knowledge of the events.

As to item (2), a grantable petition under 35 U.S.C. § 116 and 37 CFR 1.47 requires an oath or declaration signed by the available inventor on behalf of the non-signing inventor. An oath or declaration for the patent application in compliance with 37 CFR 1.63, 1.64 and 1.175 has not been presented and is REQUIRED. See MPEP 409.03(a).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Special Program Law Office

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

After this decision is mailed, deposit account No. 03-1952 will be charged the fee for the petition under 37 CFR 1.47 (\$130.00, fee code 122), as authorized in the transmittal letter.

Telephone inquiries related to this decision should be directed to the undersigned at (703) 306-3159.



Karin Tyson
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Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects